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EXAMINER

WOOD, WILLIAM H

ART UNIT PAPER NUMBER

2193

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,471

Applicant(s)

KAWANO ET AL.

Examiner

William H. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: 012904

DETAILED ACTION

Claims 1-8 are pending and have been examined.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed.

Information Disclosure Statement

2. The Information Disclosure Statement filed on 28 January 2004 has been considered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 is directed toward software alone and is therefore not patentable.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

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assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. **10/694,777** in view of **Gronemeyer** et al. (USPN 6,363,359).

This is a provisional obviousness-type double patenting rejection.

Current Claim 1

10/694,777, claim 1 disclosed:

A software updating system, comprising: a plurality of update data supplying apparatuses for supplying update confirmation information regarding the presence or absence of updates for predetermined software via a network; an electronic device for executing a process in accordance with said update confirmation information supplied from said update data supplying apparatus, wherein said electronic device includes: judging means for judging whether or not, among installed software, there exists software for which the presence of updates needs to be confirmed; detection means for detecting said update data supplying apparatus to which an inquiry is to be made on the presence of updates for said software for which said judging means has judged a confirmation

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to be necessary; inquiring means for making an inquiry on the presence of updates for said software to said update data supplying apparatus detected by said detection means; and execution means for executing a process based on said update confirmation information supplied from said update data supplying apparatus in response to said inquiry made by said inquiring means, and said update data supplying apparatus includes: confirmation means for confirming the presence or absence of updates for said software regarding which there was an inquiry on the presence of updates by said inquiring means of said electronic device; and supplying means for supplying to said electronic device said update confirmation information in accordance with a confirmation result by said confirmation means.

Gronemeyer disclosed acquisition means for acquiring update management data indicating a timing for confirming the presence of updates for installed software (column 6, lines 64-65, the timing of when the sentinel is loaded; additionally column 2, lines 58-65); and storage means for storing said update management data acquired by said acquisition means (column 6, lines 64-65, the sentinel is stored).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the software updating system of **10/694,777** with timing information for performing a timing as found in **Gronemeyer's** teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to self-test and thus ensure system integrity (**Gronemeyer**: column 6, line 61 to column 7, line 2).

Current Claim 2

10/694,777 claim 2 disclosed:

The software updating system according to claim 1, wherein said update confirmation information is one of update data for updating said software and information indicating the presence or absence of updates.

Current Claim 3

In view of **10/694,777** and **Gronemeyer** for claim 1 above, **Gronemeyer** disclosed the software updating system according to claim 1, wherein said update management data is attached to said installed software, and said acquisition means of said electronic device acquires said attached update management data from said installed software (column 7, lines 25-26, "configuration log").

Current Claim 4

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In view of **10/694,777** and **Gronemeyer** for claim 1 above, **Gronemeyer** disclosed the software updating system according to claim 1, wherein said acquisition means of said electronic device acquires said update management data from a developer of said installed software (*column 7, lines 25-26, "configuration log", installed software originates from a developer*).

Current Claims 5-8

Substantially the same as for claims 1-4.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-8 are rejected under 35 U.S.C. 102(a) as being anticipated by **Gronemeyer** et al. (USPN 6,363,359).

Claim 1

Gronemeyer disclosed a software updating system, comprising:

an update data supplying apparatus for supplying update confirmation information regarding the presence or absence of updates for predetermined software via a network (*figure 4, elements 342 and 344; column 7, lines 56-58, "server"*);

an electronic device for executing a process in accordance with said update confirmation information supplied from said update data supplying apparatus (*figure 4, element 302; column 7, lines 52-54, "client computing device"*), wherein

said electronic device includes:

acquisition means for acquiring update management data indicating a timing for confirming the presence of updates for installed software (*column 6, lines 64-65, the timing of when the sentinel is loaded; additionally column 2, lines 58-65*);

storage means for storing said update management data acquired by said acquisition means (*column 6, lines 64-65, the sentinel is stored*);

judging means for judging based on said update management data whether or not, among said installed software, there exists software for which the presence of updates needs to be confirmed (*figure 3, element 202; column 7, lines 25-26*);

detection means for detecting said update data supplying apparatus to which an inquiry is to be made on the presence of updates

for said software for which said judging means has judged a confirmation to be necessary (*figure 3, element 206; column 7, lines 31-32*);

inquiring means for making an inquiry on the presence of updates for said software to said update data supplying apparatus detected by said detection means (*figure 3, element 208; column 7, lines 56-58*); and

execution means for executing a process based on said update confirmation information supplied from said update data supplying apparatus in response to said inquiry made by said inquiring means (*figure 3, element 210*), and

said update data supplying apparatus includes:

confirmation means for confirming the presence or absence of updates for said software regarding which there was an inquiry on the presence of updates by said inquiring means of said electronic device (*column 7, lines 56-58, to send update options those options are first determined, not "available"*); and

supplying means for supplying to said electronic device said update confirmation information in accordance with a confirmation result by said confirmation means (*column 7, lines 56-58*).

Claim 2

Gronemeyer disclosed the software updating system according to claim 1, wherein said update confirmation information is one of update data for

updating said software and information indicating the presence or absence of updates (*column 7, lines 56-28*).

Claim 3

Gronemeyer disclosed the software updating system according to claim 1, wherein said update management data is attached to said installed software, and said acquisition means of said electronic device acquires said attached update management data from said installed software (*column 7, lines 25-26, "configuration log"*).

Claim 4

Gronemeyer disclosed the software updating system according to claim 1, wherein said acquisition means of said electronic device acquires said update management data from a developer of said installed software (*column 7, lines 25-26, "configuration log", installed software originates from a developer*).

Claims 5-8

The limitations of claims 5-8 are substantially the same as for claims 1-4 and as such are rejected in the same manner.

Correspondence Information

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 9:00am - 5:30pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)-272-3719. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see <http://pair-direct.uspto.gov>. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



William H. Wood
Patent Examiner
AU 2193
September 18, 2006